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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/021,421      02/10/98      JORDAN      R      8020/002

024283      HM22/0926  
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EXAMINER

GOLDBERG, J

ART UNIT

PAPER NUMBER

1614

DATE MAILED:

09/26/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/021,421

Applicant(s)

Jordan

Examiner

Jerome D. Goldberg

Group Art Unit

1614



☒ Responsive to communication(s) filed on Aug 10, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-33 is/are pending in the application.

Of the above, claim(s) 23-33 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-22 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1614

Claims 23-33 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Applicant timely traversed the restriction (election) requirement in Paper No. 11.

Applicants' remarks are noted but the other invention will support a separate patent.

The claims are still being examined as they read on the zinc salt.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over the EP 0506207 Az <sup>proposed - c2 d</sup> and the GB 1215676. The EP discloses the zinc salt forms a chelate or complex in a equimolar ratio (page 3, lines 22-25) with 8- hydroxyquinoline sulfate (page 4, lines 18-19). The

Art Unit: 1614

EP further, teaches carrier for said complex (page 5, lines 39-43). The GB patent teaches applicants' complex (page 1, bottom table) and that said complexes show "no side effects against human beings" (page 1, col 1, lines 30 and col. 2, line 55). The two patent do not teach all of the claimed carriers. Accordingly, one skilled in this art would be motivated to obtain the claimed composition from the prior composition in the absence of a side-by-side comparison.

Claims 1 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1 and 22 fail to differ in scope since the composition in both claims are the same. Correction is required.

Claims 1-22 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the specific cancerous lesions and/or precancerous lesions disclosed, does not reasonably provide enablement for the term "cancerous lesions" or "precancerous lesions". The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. The terms "cancerous lesions" and "precancerous lesions" in claims 1-22 lack clear exemplary support in the specification as filed.

The cancer therapy art remains highly unpredictable, and no examples exist for efficacy of a single product against cancerous or preconceous lesions generally. Therefore, based on the unpredictable nature of the invention and state of the prior art, lack of guidance and working

Art Unit: 1614

example, and extreme breadth of the claims, one skilled in the art could not use the entire scope of the claimed invention without undue experimentation.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner J. D. Goldberg, whose telephone number is (703) -308-4606. The examiner can normally be reached on Monday through Thursday from 9:00 am to 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Cintins, can be reached on (703) -308-4725. The fax phone number for the organization where this application or proceeding is assigned is (703) -308-4556 or 305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) -308-1235.

Goldberg/LR

September 8, 2000

A handwritten signature in black ink, appearing to be 'JD Goldberg', with a large, sweeping flourish at the end.